REMARKS

This is in response to the non-final Official Action currently outstanding with respect to the above-identified application.

The present application was originally filed with Claims 1 - 7. By the previous Amendment, Claims 2 – 3 and 5 - 7 were amended; Claims 1 and 4 were canceled, without prejudice; and New Claims 8 and 9 were added. By the foregoing Amendment, Claim 5 and 9 are amended. Accordingly, upon the entry of the foregoing Amendment, Claims 2, 3 and 5 - 9, as amended hereinabove, will constitute the claims under active prosecution in this application.

The foregoing Amendment states the status of all of the claims and the current text of all of the presently pending claims as required by the Rules.

In the currently outstanding Official Action, the Examiner has:

1.Failed to re-acknowledge Applicant's claim for foreign priority under 35 USC 119(a)-(d) or (f), and reconfirm the receipt by the United States Patent and Trademark Office of the required certified copy of the priority document. Appropriate re-acknowledgement and reconfirmation in response to this communication is respectfully requested in order to preserve the accuracy and clarity of the present record;

2. Provided Applicant with a copy of a Form PTO-892 (Notice of References Cited) and copies of each of the newly cited references listed therein;

3. Failed to reconfirm that the drawings originally filed with this application on 29 December 1999 are accepted as formal drawings. Appropriate reconfirmation of the acceptability of the drawings presently on file in response to this communication is respectfully requested for the same reasons as set forth in item 1 above;

4. Withdrawn his prior indication of the allowabilty of Claims 2, 4 and 6 in view of the newly discovered Koerich, et al reference ("A System for Automatic Extraction of the User-Entered Data from Bankchecks", Proc. SIBGRAPI '98, Int. Symp. On Computer Graphics, Image Processing and Vision, October 20, 1998, pp. 270-277)

5. Suggested that the words "replaced with" at page 20, line 15 of the present specification should read -- replaces the --;

6. Suggested that the words "prior to the next sequential input of another of the kinds of images" added by the previous amendment constitutes so-called "new matter", and required the cancellation thereof in response to the currently outstanding Official Action;

7. Rejected Claims 3 and 9 under 35 USC 112, first and second paragraphs respectively, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time this application was filed, had possession of the claimed invention; and as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention, respectively, because Claim 3 contains the wording deemed to be so-called "new matter" and because Claim 9 is dependent upon canceled Claim 4;

8. Rejected Claims 2 and 4 under 35 USC 103(a) as being unpatentable in view of the Koerich, et al reference;

9. Objected to Claims 5 and 6 as being dependent upon a rejected base claim, but also indicated that those claims would be allowable if rewritten in independent form including all of the limitations of their respective base claims and any intervening claims;

10. Objected to Claim 8 on the basis that it substantially duplicates Claim 5;

11. Indicated that the subject matter of Claims 3, 8 and 9 has not been found in the prior art, but those claims cannot be allowed because Claim 3 contains so-called "new matter" and because Claim 8 substantially duplicates Claim 5;

12. Cited certain additional references as being pertinent to Applicant's disclosure, but not applied any of those references against any of the currently pending claims.

Further comment in these Remarks regarding items 1-3 and 12 above is deemed not to be necessary.

With respect to item 4, Applicant will discuss the substantive basis of the Examiner's withdrawal of his prior indication of the allowability of Claims 2, 4 and 6 in connection with his rejections of those claims in the currently outstanding Official Action with regard to item 8 below.

With regard to item 5, Applicant agrees with the Examiner that the words "replaced with" at page 20, line 15 of the present specification should read -- replaces the--. An appropriate amendment to the present specification making that change is presented above.

With respect to items 6, 7 and 11 above (the Examiner's assertion that Applicant's addition of the words "prior to the next sequential input of another of the kinds of images" constitutes improper so-called "new matter" that must be canceled in response to the currently outstanding Official Action), Applicant respectfully **traverses** the Examiner's conclusion, requirement for cancellation and related claim rejections.

The basis for this traversal is that Applicant respectfully submits that the Examiner has failed to understand the true nature and scope of the specification as filed. The reason for this is not apparent to the Applicant because the wording questioned by the Examiner is clearly and definitely supported by the specification of this application as filed.

In the above regard, attention is directed particularly to the present specification at page 16, line 3 to page 18, line 16 as a representative example of the disclosure of the subject matter that the Examiner has characterized as "new matter". Applicant respectfully submits that a full and detailed reading of at least the just identified portion of the specification clearly indicates that document A is placed on the scanner base, the pre-scan button is pressed, the scanner reads the document A and the read image of document A is stored in the storing means 5 (see page 16, lines 3-11). The foregoing constitutes step a1.

Then, at step a2, the user removes document A from the scanner bed, places the document B on the scanner bed, and adjusts the positional alignment of document B on the scanner bed so as to match the previous position of document A thereon. Then the extraction button is pressed (step a3), followed by the pressing of the pre-scan button. Scanning of the document B commences in response to activation of the pre-scan button. At the same time, the comparing means compares on a pixel-by-pixel basis the image of the document B being read *with the image of document A stored in storing means 5* (see page 16, line 12 to page 17, line 4, emphasis added, step a4). The comparison result is stored in storage means 5.

Thus, Applicant respectfully submits that it is abundantly clear that the scanning of document B does not occur until after both the scanning of the document A and the storage of the image of document A in storing means 5 has been completed.

Similarly, at page 17, lines 5-8, it is stated that: "*When scanning of the document B and comparing the document B with the document A for all the pixels is finished,* the user removes the document B from the document base 21 and puts a third document C on the document base 21 at step a5". (Emphasis added) This clearly suggests, if it does not specifically state, that the comparison image of documents A and B resides in the storage means 5 upon the completion the scanning and comparison of documents A and B.

Lest there be any confusion on the latter point, however, the specification goes on at page 17, lines 15-24, to explain that after the alignment of the document C with the previous position of document A on the scanner bed 21, scanning of document C is commenced. "*Image information on the document C read by the scanner 1 is compared with the storage contents of storage means 5 on a pixel-by-pixel basis with by the comparing means 4 at step a7.* **In the storage means 5, *a portion common to the document A and the document B is stored,* and as a result of the comparing of document C with the storage contents, an image of a portion common to the documents A, B and C is supplied as a comparison result from the comparing means 4 to the output means 6.**"

Therefore, contrary to the Examiner's assertion in the currently outstanding Official Action, the present specification clearly and unambiguously discloses that each type of image is scanned, compared with the image information then in the storage means 5, and the result of that comparison is stored in the storage means 5 **prior to the next sequential input of another of the kinds of images**.

Indeed, if this were not the case, a situation could arise in which document B could not be compared with document A as represented by the content of storage means 5 because the storage of document A into storage means 5 was not complete at the time of the comparison. Similarly, if the storage of the next previous comparison result in the storage means 5 is not complete prior to the next sequential image input, the comparison result would not represent the comparison of the input image with the comparison result of all of the previously input images. This is not what the above-discussed portion of the specification clearly describes, nor does it represent the overall teachings of the present specification to one of ordinary skill in the art.

Stated slightly differently, whether the input image is compared with the stored image as it is being input and the comparison result replaces the previously stored data during the ongoing course of the scanning/comparison, or the input image is completely input prior to the comparison with the comparison result replacing the previously stored information, the stored image will have been replaced prior to the next sequential input of another of the kinds of images. Any other reading of the specification would not be reasonable. This is because any other construction of the meaning of the specification would result in either a failure to compare all of the images with each other in the course of the creation of the final stored resultant image information as described in the specification, or in the presence of apparatus for storing at least part of the previous image and at least part of the current image at the same time in a manner not specifically recited in the preferred embodiments described in the specification.

Accordingly, Applicant respectfully submits that the Examiner's conclusion that the phrase "prior to the next sequential input of another of the kinds of images" constitutes so-called new matter that must be cancelled is in error. The wording questioned by the Examiner is clearly supported by the specification at least at the portion thereof referred to immediately above. Therefore, withdrawal of the Examiner's outstanding "new matter" and related 35 USC 112 rejections of Claims 3 and 9 in response to this communication is respectfully requested.

With respect to the dependency of Claim 9, Applicant notes that in the previous Amendment the correct dependency of Claim 9 on Claim 8 appears in the clean set of claims at the beginning of the Amendment document but inadvertently is misstated in the Version Showing the Changes Made to the Claims appearing as an attachment to the Amendment. To correct this point of confusion, Applicant by the foregoing Amendment has correctly indicated that Claim 9 is dependent upon Claim 8. Applicant regrets any inconvenience caused by this inadvertent error. Allowance of the foregoing Amendment of Claim 9 in response to this communication, therefore, is respectfully requested.

With respect to the Examiner's rejection of Claim 8 on the basis that it duplicates Claim 5, Applicant again respectfully **traverses** the Examiner's rejection. In this regard, Applicant respectfully submits that the Examiner has failed to adequately analyze the claims. Specifically, to the extent relevant to the Examiner's duplicity rejection, it is respectfully noted that Claim 2 is directed to an image processing apparatus comprising ***extracting means***. Claim 5 is directed to an image processing apparatus comprising both **extracting and eliminating means**. Finally, Claim 8 is to an image processing apparatus comprising **eliminating means.**

Accordingly, Applicant respectfully submits that Claims 5 and 8 are respectively clearly of different scope. Consequently, Claims 5 and 8 are not duplicative of one another. A decision withdrawing the outstanding rejection of Claim 8 as being duplicative of Claim 5 in response to this communication, therefore, is respectfully requested.

With respect to item 8 above, the Examiner's rejection of Claims 2 and 7 as being unpatentable under 35 USC 103(a), Applicant respectfully notes that the Examiner himself has admitted that the Koerich reference fails to disclose that the original (reference) image stored in the storage means is inputted via the input means (scanner). The Examiner asserts, however, that since the database is disclosed as storing images, it would have been obvious to one of ordinary skill in the art at the time the present invention was made to utilize the scanner already present as a means for inputting the original (reference) image as well as the images that are subsequently to be subjected to comparison. This initially seems to be a subjectively appealing argument. However, upon further consideration, it will be realized that the Examiner's argument totally fails to acknowledge the fact that the database of the Koerich reference also includes parameters and data that interact with the image data (no matter how that image data was created) in the computer so as to create a virtual "template" as the reference image.

Thus, the Koerich and similar references do not contemplate that a reference image will be input and stored as herein claimed for subsequent comparison to other images. Instead, the Koerich and similar references contemplate that for each document from which extraction of so-called user entered data is to take place some sort of a "virtual template" will be generated (presumably by a computer) that is specific to the peculiarities of document under consideration, i.e., in Koerich checks issued by each issuing bank and the peculiarities associated with the check's issuing payor. Further, the computer program is contemplated by Koerich to automatically compensate for positional shifts between the template's spacial disposition and spacial disposition of a specific check image input's disposition relative to one another. The result, therefore, is that the initial algorithm produces from the document under analysis and the generated "virtual template" five spacially aligned sub-image fields for further analysis, namely, the digit amount, the worded amount, the payee's name, the place and date, and the signature.

Applicant respectfully submits that the conclusion is inescapable that the Koerich reference and those similar to it do not teach or disclose the present invention, and that they would not have suggested the present invention to a person of ordinary skill in the art at the time that the present invention was made. None of these references start with the simple scan and store of a basic initial image. Instead, they all are concerned with the creation of so-called "templates" free from printing distortion and other non-user-entered material to which comparisons of filled out forms can be made. Accordingly, these references teach away from making direct comparisons between images that are input and stored with subsequently input images as herein claimed.

Stated slightly differently, the cited reference teaches the artificial creation (generation) of "idealized" virtual stored images to which numerous actual individual input documents may be sequentially compared to extract particular types of data rather than all data satisfying a preselected criteria. This clearly is not the same thing as the present invention wherein each input image after the first is compared with all of the input images that have gone before it in the generation of a composite comparison output. In summary, a system for comparing individual input documents individually to a computer generated, "virtual template" is simply not the same thing, nor does it render obvious, a system in which images are effectively cumulatively compared with one another in the derivation of a final output result.

Finally, with respect to item 9, Applicant now has amended Claim 5 so that it is stated in independent form including all of the limitations of its base claim and any intervening claims as suggested by the Examiner for the purposes of placing Claims 5 and 6 (dependent upon Claim 5) in condition for allowance. Applicants adoption of the Examiner's suggestion in this regard is specifically without prejudice to the foregoing discussion of the Examiner's rejection of Claims 2 and 4 under 35 USC 103(a).

For each and all of the foregoing reasons and in light of the foregoing Amendment, Applicants respectfully submit that all of the claims currently pending in this application (i.e., Claims 2-3 and 5-9) now are in condition for allowance. Accordingly, entry of the foregoing Amendment, and reconsideration and allowance of the present application as so amended in response to this communication are respectfully requested.

Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

Date: June 16, 2003

By: _David A. Tucker_
David A. Tucker
Reg. No. 27,840
Attorney for Applicant(s)

EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, Massachusetts 02109
(617) 517-5508
332761v2

21874
PATENT TRADEMARK OFFICE